

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 15353US02)

In the Application of:

King Chung

U.S. Serial No.: 10/805,016

Filed: March 19, 2004

For: ENHANCING COCHLEAR
IMPLANTS WITH HEARING
AID SIGNAL PROCESSING
TECHNOLOGIES

Examiner: BOCKELMAN, MARK

Group Art Unit: 3766

Conf. No.: 7796

Customer No.: 23446

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PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: April 7, 2010

By: /Philip Henry Sheridan/
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REMARKS

The present application includes pending claims 1-24, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject mater.

Claims 1-3, 5, 9-11, 13-14 and 17-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller (U.S. Patent No. 6,620,094) in view of any one of Nielsen et al. (U.S. Patent No. 6,839,447, hereinafter "Nielsen"), Killion et al. (U.S. Patent No. 5,524,056, hereinafter "Killion"), Borstel (U.S. Patent No. 4,467,145), Nordqvist et al. (U.S. Patent No. 6,862,359, hereinafter "Nordqvist") or applicant's admitted prior art in paragraph [0011] (hereinafter "AAPA").

Claims 4, 6-8, 12 and 15-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller alone or in view of Griffith et al. (U.S. Patent No. 6,842,647, hereinafter "Griffith").

The Applicant respectfully traverses the rejections for at least the following reasons.

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

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See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

Regarding claim 1, the Applicant respectfully submits that the combination of Miller in view of any one of Nielsen, Killion, Borstel, Nordqvist and AAPA fails to teach, suggest, or disclose, for example, “**said hearing aid preprocessing device** comprising...; and **said existing cochlear implant comprising**: at least one cochlear implant signal input device, comprising one or both of a cochlear implant direct audio input and a wireless receiver for receiving said processed signals from said hearing aid preprocessing device; a second processor that processes and encodes said signals received by said at least one cochlear implant signal input device, **a transmitter for transmitting said processed and encoded signals to an implanted portion of said existing cochlear implant**; wherein said existing cochlear implant is retrofitted with said hearing aid preprocessing device by **communicatively coupling an output of said hearing aid preprocessing device with one or both of said at least one cochlear implant signal input device of said existing cochlear implant**,” as set forth in Applicant’s independent claim 1.

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The Office Action states that the Examiner interprets Miller's teaching of an external portion 306 and an implanted portion 307 of a semi-implanted hearing aid device 300 as disclosing an existing cochlear implant retrofitted with a hearing aid preprocessing device, as set forth in the Applicant's independent claim 1. (*See e.g.*, Office Action, Response to Arguments, Page 3). However, the Applicant notes that nowhere in the combination of references is there any disclosure regarding retrofitting an existing cochlear implant with a hearing aid preprocessing device.

Additionally, even if Miller's implanted portion 307 could be considered an existing cochlear implant as alleged by the Office Action (which is clearly unsupported by the cited references), the Applicant notes that Miller's implanted portion 307 is clearly different than **"said existing cochlear implant comprising: at least one cochlear implant signal input device, comprising one or both of a cochlear implant direct audio input and a wireless receiver for receiving said processed signals from said hearing aid preprocessing device; a second processor that processes and encodes said signals received by said at least one cochlear implant signal input device, a transmitter for transmitting said processed and encoded signals to an implanted portion of said existing cochlear implant,"** as set forth in Applicant's independent claim 1. Specifically, Miller's implanted portion 307 cannot comprises a transmitter for transmitting said processed and encoded signals **to an implanted portion of said existing cochlear implant** because Miller's implanted portion 307 is the implanted portion of Miller's semi-implanted hearing aid device 300. Thus, the Applicant respectfully submits that the Examiner's interpretation that Miller's teaching of an external portion 306 and an implanted portion 307 of a semi-implanted hearing aid device 300 discloses an existing cochlear implant retrofitted with a hearing aid preprocessing device, **amounts to clear error**.

The Applicant notes that Griffith fails to remedy the deficiencies of Miller, Nielsen, Killion, Borstel, Nordqvist and AAPA. The Applicant further notes that dependent claims 2-24

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depend from independent claim 1 and are therefore allowable for at least the reasons set forth above with regard to independent claim 1.

Thus, Applicant respectfully submits that claims 1-24 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: April 7, 2010

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